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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/080,684 05/18/98 MIKUS T TH-1038

PM82/1104

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INTELLECTUAL PROPERTY
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EXAMINER

TAYLOR, D

ART UNIT

PAPER NUMBER

3673

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DATE MAILED:

11/04/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/080,684

Applicant(s)

Mikus, T. et al

Examiner

Dennis L. Taylor

Group Art Unit

3673



☒ Responsive to communication(s) filed on Sep 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

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Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) 2-5 and 10 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 6-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election of species has been required in this application. In paper No. 10, Applicants elected the species shown in Figure 2, which include claims 1, 2 and 5-9. Further, Applicants state that claims 1, 2 and 6-9 are generic. The examiner does not agree. Claim 2, for example, clearly reads on Figure 1. Further, since claim 5 depends from claim 2, it likewise does not read on the elected species. Also, claim 10 does not read on any figure. Claim 1, from which claim 10 depends, recites that the contaminated soil is heated by providing combustion gases to at least one essentially horizontal conduit, whereas claim 10 recites that the heating takes place by a surface heater placed above the soil surface. No such structure is shown or described.

Therefore, claims 2-5 and 10 are withdrawn from further consideration by the examiner as not readable on the elected species. Applicants have indicated that claims 3 and 4 do not read on the elected species. Further, it is clear that claims 2 and 5 do not read on the elected species. Also, Applicant has made no mention of claim 10, which clearly does not read on the elected species.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) for reasons as set forth in paper No.
6. The drawings must show every feature of the invention specified in the claims. Therefore, the

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features recited in the claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

2. *Claim Rejections - 35 USC § 112*

3. Claims 1 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 1, it is not clear how the combustion gases are passed through the soil and not injected into the contaminated soil because there is no method steps set forth in the claim that would preclude the gases from being injected into the soil. Further, it is not clear where the "horizontal conduit" through which the contaminated vapors are located. Claims 6-9 are indefinite because they depend from an indefinite base claim. As to claim 10, it is not clear what structure/method steps are being claim because there is no embodiment disclosed that the claim reads on.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (U.S. 5,271,693). With respect to claim 1, Johnson et al teach placing a plurality of horizontal conduits in contaminated soil, heating the contaminated soil and removing vaporized contaminants from the contaminated soil by drawing the vaporized contaminants into at least one essentially horizontal conduit through perforations in the conduit. Since there is no method steps set forth in the claim that gives any significance as to any new or unobvious results obtained by passing gas through a conduit for the purposes of heating the soil, the heaters of Johnson et al are considered the full functional equivalent of the gas conveying conduits set forth in the claim. As to claim 6, see Figure 3 of Johnson et al. As to claim 7, the particular manner in which the conduits are placed in the vicinity of the contaminated soil is not considered to be a patentable distinction because it is old and well known in the art to place such conduits in a trench. As to claims 8 and 9, Johnson et al teach the structure recited in this claim.

Response to Arguments


6. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Taylor whose **telephone number is (703) 308-1013**. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell, can be reached on (703) 308-2151. The **fax phone number for this Group is (703) 305-3597**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.


DENNIS L. TAYLOR
PRIMARY EXAMINER
ART UNIT 3672

October 25, 1999
080684.2nd